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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,535	10/15/2004	Hui-Fang Chang	100695-1P US	4411

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ASTRA ZENECA PHARMACEUTICALS LP  
GLOBAL INTELLECTUAL PROPERTY  
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WILMINGTON, DE 19850-5437

EXAMINER

DESAI, RITA J

ART UNIT PAPER NUMBER

1625

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/511,535

Applicant(s)

CHANG ET AL.

Examiner

Rita J. Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/17/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 14-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 14-17, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

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### DETAILED ACTION

Applicants have elected group I, Claims 1-4, 18 and 19 drawn to compounds of formula I, without traverse.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by by

Eifion US 6569865 B2 ( priority provisional US 60/367351)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference

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claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

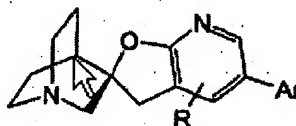
A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 18 and 19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 of U.S. Patent No. 6569865 and claim 8 (column 39, lines 16-17) of US 6110914. US6995167, US 10/511525,

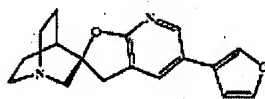
Although the conflicting claims are not identical, they are not patentably distinct from each other because

Applicants claims are drawn to



wherein Ar is a furyl

group substituted by substituents.



And the prior art compound is

wherein the furyl is not

substituted.

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The only difference between the compounds of the prior art and the instant application are that, in the application the furyl is substituted by a number of different options, amongst which is an alkyl.

A hydrogen verses an alkyl is an obvious variant and is prima facie obvious to modify it with the alkyl substituent.

Claims 1-4, 18 and 19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. US 2003149065, US 2005250802, Loch James III and also 10/511535 Phillip et al .. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the same reasons as given above.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

Claims 1-14, 18 and 19 are rejected under 35 U.S.C. 103(a) as being obvious over WO 99/03859 Phillips et al , US 6110914 Eifion Phillips et al. WO 2002096912 US6995167 , US 2003149065, US 2005250802, Loch James III (WO 0042044) And Phillips et al, US 6569865, US 10/511525,

The applied reference has a common inventor/assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a

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showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

The reference discloses compounds of the invention wherein the furyl is not substituted.

Applicants compounds have it substituted by a number of options, amongst which is an alkyl.

"H" verses an "alkyl" is an obvious variant and is considered to be prima facie obvious modification.

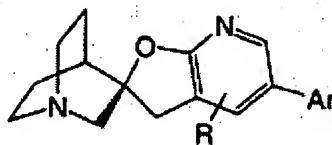
The same reasoning applies for 5 U.S.C. 103(a) as being obvious over Eifion US 6569865 B2 ( priority provisional US 60/367351)

Applicants compounds and the compounds of the prior art have a very close structural similarity.

The core is the same only the type of the het group (Ar) group is different.

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Applicants compounds have



wherein Ar is a

het ring with 1 oxygen.

While homology is considered to be present, even if true "homology" is not present, such does not defeat the prima facie case of obviousness raised by the art. In *reDruey et al* 50 CCPA 1538, 319 F. 2d 237, 138 USPQ 39 wherein Judge Worley, delivering the Courts's opinion stated:

"We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants that the term homologue is used by chemists at times in a broad sense, and at other times in a narrow or strict sense. The name used to designate the relationship between the related compound is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound." 50 CCPA 1541.

*Also as the Court stated in, In re Payne et al., 606 F. 2d 302, 203 USPQ 245 at 255 (CCPA 1979):*

"the name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new composition."

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In addition, any question of why would one conceive and use the similar compounds (i.e. motivation') is answered by the Court I In re Gyurik et al., 596 F 2d 1012, 201 USPQ 552 at 557.

“ In obviousness rejections based on close similarities in chemical structure, the necessary motivation to make the claimed compound, and thus the prima facie case of obviousness, rises from the expectation that compounds similar in structure will have similar properties.”

### ***Conclusion***

Claims 1-4, 18 and 19 are not allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rita J. Desai whose telephone number is 571-272-0684. The examiner can normally be reached on Monday - Friday, flex time..

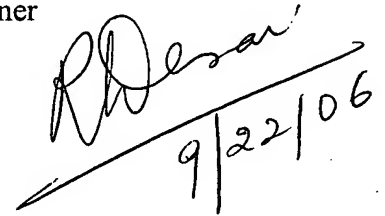
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Rita J. Desai  
Primary Examiner  
Art Unit 1625

A handwritten signature, likely of Rita J. Desai, is written in cursive. Below the signature, the date "9/22/06" is written in a similar cursive style, with a horizontal line drawn across the date.

R.D.  
September 20, 2006